Supreme Court, U.S.
FILED
OCT 9 1997
CLERK

No. 97-436

IN THE
Supreme Court of the United States
OCTOBER TERM, 1997

SASHCO, INC.,
Petitioner,

v.

DAP PRODUCTS INC.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

---

RESPONDENT'S BRIEF IN OPPOSITION

JEFFREY T. COX
Counsel of Record
PAUL G. HALLINAN
THOMAS R. KRAEMER
FARUKI GILLIAM & IRELAND P.L.L.
600 Courthouse Plaza, S.W.
10 North Ludlow Street
Dayton, Ohio 45402
(937) 227-3704
Counsel for Respondent DAP Products Inc.

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

QUESTION PRESENTED

Whether certiorari is warranted to review the decision of the United States Court of Appeals for the Federal Circuit affirming the district court's finding that two patents owned by Petitioner are not infringed by any product made, used or sold by Respondent where:

(1) the district court issued a lengthy opinion setting forth with particularity the methodology it used to interpret the claims of Petitioner's patents;

(2) the district court did not depart from the proper methodology for interpreting patent claims and, in fact, followed the methodology urged by Petitioner;

(3) the Court of Appeals found that Petitioner had failed utterly to raise an issue on appeal necessitating a written opinion and, accordingly, affirmed the district court's decision without opinion pursuant to Fed. Cir. R. 36;

(4) there is nothing in the record to suggest that the Court of Appeals did not review the district court's decision *de novo*; and

(5) the Court of Appeals denied Petitioner's combined petition for rehearing and suggestion for rehearing in banc.

RULE 29.6 STATEMENT

The parent company of DAP Products Inc. is Wassall Netherlands, B.V. The parent company of Wassall Netherlands, B.V. is Wassall PLC.

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	v
STATEMENT OF THE CASE	1
A. The '458 Patent Covers Only the Combination of Clear Caulk in a Clear Cartridge Such that the User Can See Completely Through the Cartridge from One Side to the Other	2
B. Sashco's Admissions During the Prosecution of the '458 Patent Application Confirm Its Narrow Scope	4
C. The '014 Patent Covers Only the Combination of Clear Caulk in a Clear Squeeze Tube that Contains a Region of Reduced Thickness in a Uniform, Flattened Configuration	6
D. The Accused DAP Products Do Not Fall Within the Scope of Sashco's Patents	7
E. The District Court Determined that Sashco's Patents Are Not Infringed by Any Product Made, Used or Sold by DAP, and the Federal Circuit Affirmed	9
REASONS FOR DENYING THE PETITION	9
I. THE DISTRICT COURT CORRECTLY CONSTRUED SASHCO'S PATENTS USING PROPER CLAIM CONSTRUCTION METHODOLOGY	9
A. The District Court Correctly Found No Infringement of the '458 Patent	10
1. DAP's cartridge product is not covered by the '458 Patent	10
2. The district court did not err in consulting dictionaries during its claim construction	11

TABLE OF CONTENTS—Continued

Page

3. Even if the district court looked first at dictionary definitions (which it did not), a dictionary may be consulted at any time during claim construction 13

4. The district court did not err in analyzing the '458 Patent as a tubular cartridge..... 14

B. The District Court Correctly Found No Infringement of the '014 Patent 15

II. SASHCO HAS RAISED NO SIGNIFICANT LEGAL ISSUE OF GENERAL APPLICATION BUT, RATHER, ASKS THE COURT TO CORRECT CLAIM CONSTRUCTION WITH WHICH IT DISAGREES 17

III. SASHCO HAS NO "RIGHT" TO AN OPINION ON APPEAL, AND SASHCO CAN POINT TO NO EVIDENCE THAT THE FEDERAL CIRCUIT DID NOT REVIEW THE DISTRICT COURT'S DECISION *DE NOVO* 19

CONCLUSION 20

TABLE OF AUTHORITIES

CASES — Page

Furman v. United States, 720 F.2d 263 (2d Cir. 1983) 19

Hoechst Celanese Corp. v. B P Chem., 78 F.3d 1575 (Fed. Cir.), *cert. denied*, —— U.S. ——, 117 S. Ct. 275 (1996) 13

Layne & Bowler Corp. v. Western Well Works, Inc., 261 U.S. 387, 43 S. Ct. 422 (1923) 18

Magnum Import Co. v. Coty, 262 U.S. 159, 43 S. Ct. 531 (1923) 17

Markman v. Westview Instruments, 52 F.3d 967 (Fed. Cir. 1995), *aff'd*, —— U.S. ——, 116 S. Ct. 1384 (1996) 13

NLRB v. Amalgamated Clothing Workers of Am., 430 F.2d 966 (5th Cir. 1970) 19

North Am. Vaccine v. American Cyanamid Co., 7 F.3d 1571 (Fed. Cir. 1993), *cert. denied*, 511 U.S. 1069, 114 S. Ct. 1645 (1994) 17

Taylor v. McKeithen, 407 U.S. 191, 92 S. Ct. 1980 (1972) 19

United States Surgical Corp. v. Ethicon, Inc., 103 F.3d 1554 (Fed. Cir. 1997) 19

United States v. Baynes, 548 F.2d 481 (3d Cir. 1977) 19

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 (Fed. Cir. 1996) 13

STATUTES

35 U.S.C. § 103 4

RULES

Sup. Ct. R. 10 18

Fed. Cir. R. 36 ..... 9, 19

OTHER AUTHORITY

Taft, C.J., in Hearings Before the House Committee on the Judiciary, 67 Cong., 2d Sess., ser. 33 (1922) 17-18

Vinson, C.J., Address to the American Bar Ass'n (Sept. 7, 1949), 69 S. Ct. v, vi 18

Roget's International Thesaurus (4th ed. 1977) 14

Webster's New Collegiate Dictionary (1981 ed.) 14

IN THE

Supreme Court of the United States

OCTOBER TERM, 1997

No. 97-436

SASHCO, INC.,

Petitioner,

v.

DAP PRODUCTS INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

---

RESPONDENT'S BRIEF IN OPPOSITION

STATEMENT OF THE CASE

This is not a case worthy of Supreme Court review. This is a commercial dispute between Petitioner Sashco, Inc. ("Sashco") and Respondent DAP Products Inc. ("DAP") that involves, *inter alia*, the issue of whether United States Patent Nos. 4,776,458 (the "'458 Patent") and 4,863,014 (the "'014 Patent"), owned by Sashco, are infringed by any product made, used or sold by DAP. Having had this question answered in the negative by both the United States District Court for the Southern District of Ohio and the United States Court of Appeals for the Federal Circuit, Sashco simply seeks a third bite of the apple by asking this Court to interpret the claims of its patents.

The question that Sashco urges this Court to address—the scope of its patents—is unique to this case and pre-

sents no legal issue of general applicability. Simply put, this is a case where Sashco urged a narrow interpretation of its claimed inventions to the patent examiner in order to obtain its patents, and then asserted a broader interpretation of its patents as to competitors. Unhappy that its attempt to expand the scope of its patents was rejected both by the district court and by the Federal Circuit, Sashco now seeks to have this Court engage in claim construction. As demonstrated below, Sashco understands neither the scope of its patents nor the role of this Court, and the petition should be denied.

A. The '458 Patent Covers Only the Combination of Clear Caulk in a Clear Cartridge Such that the User Can See Completely Through the Cartridge from One Side to the Other

The '458 Patent claims a caulking cartridge that differs from a conventional caulking cartridge only in that the cartridge is substantially transparent and is filled with a substantially transparent caulking compound. Claim 1, the only independent claim of the '458 Patent, reads as follows:

> "A product for use in the building industry, comprising a cartridge formed as an elongated tubular housing having a longitudinal axis and surrounding sidewall fabricated of a transparent material, said housing having a hollow interior, a nozzle member enclosing a downstream end of said cartridge, a substantially transparent caulking compound contained in said cartridge, said caulking compound adapted to be placed on a substrate, and a piston member slidably received in the interior of said cartridge and enclosing an upstream end thereof so that the piston member may be pressed against the caulking compound to force the caulking compound out of said nozzle member as said piston member is moved downstream through said housing to dispense said caulking material onto said substrate whereby the combination of said housing and said caulking com-

pound is substantially transparent in the transverse direction so as to allow a user to see completely through the surrounding sidewall and through the caulking compound from one side of the cartridge to the other whereby the substrate may be viewed through the combination of the housing and the caulking material placed therein so that the appe[a]rance of the substrate as affected by the caulking material may be seen prior to application of the caulking material and whereby the position of the piston member may be viewed as the caulking material is dispensed from the housing."

D-6, col. 7, ln. 27—col. 8, ln. 7. The limitations of Claim 1 consist of:

(a) a cartridge formed as an elongated tubular housing that includes:

(i) a longtitudinal axis;

(ii) a transparent sidewall;

(iii) a hollow interior;

(iv) a nozzle at one end;

(v) a piston at the end opposite the nozzle end;

(b) a substantially transparent caulking compound in the cartridge; and

(c) the result that:

(i) the combination of cartridge and caulking compound is substantially transparent in the transverse direction;

(ii) the user can see completely through the cartridge from one side to the other;

(iii) the substrate is visible through the combination of cartridge and caulking compound; and

(iv) the piston may be viewed as the caulking material is dispensed from the cartridge.

Sashco did not invent, and does not purport to have invented, a substantially transparent caulking product. In fact, Sashco admitted in the '458 Patent application that transparent caulking products already were commercially available. D-3; L-6. Similarly, Sashco does not contend that clear plastic containers were new to the art. *Id.* Accordingly, the "invention" claimed by the '458 Patent application is the combination of a known substantially clear cartridge and a known substantially clear caulking compound. However, not every such combination is covered; the '458 Patent claims only a device that is substantially transparent in the transverse direction such that the user can see completely through from one side of the cartridge to the other.

B. Sashco's Admissions During the Prosecution of the '458 Patent Application Confirm its Narrow Scope

Not surprisingly, Sashco experienced significant difficulties in obtaining a patent for its claimed invention. The application that became the '458 Patent originally contained 29 claims. L3. Claims 1-21 were withdrawn from consideration by Sashco, and Claim 22 was redesignated as Claim 1. Original Claim 22 was directed to a cartridge having a surrounding sidewall made of a transparent material and called for the "combination of said housing and said caulking compound being substantially transparent along a transverse axis of said cartridge." L20.

Claim 22 was rejected by the patent examiner as being unpatentable for obviousness over the prior art, pursuant to 35 U.S.C. § 103. L24. Following the rejection of Claim 22, the patent examiner conducted an interview of Sashco's counsel. In his interview summary record, the patent examiner stated that "Claim 22 may be allowable if the motivation and the advantage of placing transparent caulk in a transparent container is set forth in the claim *other than for viewing contents purposes.*" L26 (emphasis added).

Sashco responded to the patent examiner's action by amending Claim 22 to state that:

> "the combination of said housing and said caulking compound *is* substantially transparent *in the transverse direction so as to allow a user to see completely through the surrounding sidewall and through the caulking compound from one side of the cartridge to the other.*" (Emphasis added.)

L29. In remarks accompanying the amendment, Sashco's counsel argued:

> "Claim 22 has been amended to reflect that the product is substantially transparent in the transverse direction *across its longitudinal axis* so as to allow a user to completely see through the surrounding sidewall and through the caulking compound from one side of the cartridge to the other." (Emphasis added.)

L31.

Sashco then filed a supplemental amendment to Claim 22 further limiting that claim to a combination cartridge and caulking compound that is substantially transparent:

> "whereby the substrate may be viewed through the combination of the housing and the caulking material placed therein so that the appearance of the substrate as affected by the caulking material may be seen prior to application of the caulking material."

L35. The amendments to Claim 22 limited the claimed invention to the combination of a transparent cartridge and a transparent caulking compound that allows the user to see *completely through* the cartridge across its longitudinal axis, from one side of the cartridge to the other, and to preview the effect of the caulking compound on the substrate to which the compound is to be applied. In other words, a cartridge product that allows the user to see into, but not completely through, the combination of cartridge and caulking compound is not covered by the '458 Patent.

C. The '014 Patent Covers Only the Combination of Clear Caulk in a Clear Squeeze Tube that Contains a Region of Reduced Thickness in a Uniform, Flattened Configuration

Sashco's '014 Patent generally covers a substantially transparent sealant compound in a substantially transparent squeeze tube. The application that led to the issuance of the '014 Patent was filed as a continuation-in-part of the '458 Patent application. As in the case of the '458 Patent, the only independent claim of the '014 Patent is Claim 1. That claim requires:

> "said container having a region of reduced thickness in a direction transverse to the longitudinal axis longitudinally adjacent the upstream end of the container so that the caulking compound in the region of reduced thickness has a substantially uniform, flattened configuration and wherein said sidewall has facing sidewall portions on opposite sides of said region of reduced thickness that are fabricated of substantially transparent material whereby the substrate surface may be viewed through the combination of the facing sidewall portions and the caulking material therebetween so that the appearance of the substrate surface as affected by the caulking material may be seen prior to the application of the caulking material."

E-8, col. 7, ln. 5-18.

As with the '458 Patent, Sashco does not claim to have invented either a substantially transparent caulking compound or a substantially transparent squeeze tube; the '014 Patent covers only the combination of the two. Moreover, the patentability of the "invention" claimed by the '014 Patent was based upon the squeeze tube container having a specified region of reduced thickness in a uniform, flattened configuration opposite the nozzle end of the tube.

The necessity of the region of reduced thickness was emphasized by the patent examiner during a re-examination

of the '014 Patent. During the re-examination proceeding, the patent examiner concluded that "[t]he combination of the transparent caulking compound contained in a transparent type of squeezable container is old and conventional as clearly evidenced by the references." L43. The patent examiner affirmed patentability only because "none of the prior art fairly teaches or suggests the combination as a whole that a transparent type of squeezable container including transparent caulking compound in a region of a reduced thickness . . . . Such limitation is clearly defined at lines 15 to 28 o[f] claim 1." L43. Thus, the making, using or selling of a transparent caulking compound in a conventional, wedge-shaped transparent squeeze tube falls outside of the scope of the '014 Patent.

D. The Accused DAP Products Do Not Fall Within the Scope of Sashco's Patents

DAP and Sashco are competitors that supply a variety of caulking, sealant and weatherproofing products to the consumer and building industries. DAP formerly was a wholly-owned subsidiary of USG Corporation ("USG"). While owned by USG, DAP was known as DAP, Inc. ("Old DAP"). In the early 1970's, Old DAP began marketing a clear rubber-based sealant compound in an opaque cardboard caulking cartridge. In approximately 1990, Old DAP began to sell its clear sealant in a clear plastic cartridge, and subsequently marketed the product in a clear squeeze tube, as well.

On or about March 26, 1990, Sashco filed an action against Old DAP in the United States District Court for the District of Colorado ("the Old DAP litigation") alleging that the Old DAP cartridge product infringed its '458 Patent. Sashco later amended its complaint in that action to allege that the Old DAP squeeze tube product infringed the '014 Patent.

During the Old DAP litigation, Old DAP changed the design of its clear cartridge product to include a non-

transparent portion, or mask, that extended around approximately 58% of the cartridge. The redesigned cartridge thus contained a transparent window that allowed a user to see into, but not completely through, the cartridge. Nonetheless, Sashco erroneously continued to assert that the redesigned old DAP cartridge product infringed the '458 Patent.

Sashco's infringement claim with respect to the '014 Patent was equally specious. The squeeze tube product made and sold by Old DAP, like DAP's squeeze tube products, was marketed in a conventional wedge-shaped or toothpaste-type squeeze tube. Because a toothpaste-type squeeze tube tapers continuously from the nozzle end to the sealed end, it does not include a region of reduced thickness in a uniform, flattened configuration, as required by Claim 1 of the '014 Patent.

Effective September 20, 1991, during the pendency of the Old DAP litigation, USG sold Old DAP to a new parent company.[1] For a period of time following the sale, DAP continued to sell the redesigned clear cartridge product and clear squeeze product that Sashco alleged infringed its patents in the Old DAP litigation.[2]

In late 1992, DAP again changed the design of its clear cartridge product to include a non-transparent mask that extends around substantially all of the cartridge, except for a narrow transparent window. At the same time, DAP redesigned its squeeze tube product to provide a non-transparent mask except for a transparent window similar to the window found on the redesigned cartridge

---

[1] After the sale, USG (which no longer had an interest in defending the products at issue) settled the Old DAP litigation with Sashco.

[2] Although DAP was not a party to the settlement agreement between Sashco and USG, Sashco attempted to have DAP held in contempt for somehow violating that settlement agreement. The District Court for the District of Colorado found that Sashco's argument was meritless and discharged the show cause order.

product. Sashco does not contend that the new DAP cartridge product or the new DAP squeeze tube product infringes the '458 Patent or the '014 Patent.

E. The District Court Determined that Sashco's Patents Are Not Infringed by Any Product Made, Used or Sold by DAP, and the Federal Circuit Affirmed

In December 1995, the parties filed cross-motions for partial summary judgment. In its motion, DAP demonstrated that there are no genuine issues of material fact and that it is entitled to judgment as a matter of law declaring that neither the '458 Patent nor the '014 Patent is infringed by any product made, used or sold by DAP. In its motion, Sashco sought a declaration that the old DAP cartridge product and the old DAP squeeze tube product infringed the '458 Patent and the '014 Patent.

In an opinion issued July 17, 1996, the district court held that Sashco's patents are not infringed by any product made, used or sold by DAP; accordingly, DAP's motion for partial summary judgment was sustained on those issues, and Sashco's motion for partial summary judgment was overruled. Sashco appealed the district court's decision.

Following oral argument, the United States Court of Appeals for the Federal Circuit affirmed the decision of the district court without opinion, pursuant to Fed. Cir. R. 36. Sashco's subsequent combined petition for rehearing and suggestion for rehearing in banc was denied by the Federal Circuit.

REASONS FOR DENYING THE PETITION

I. THE DISTRICT COURT CORRECTLY CONSTRUED SASHCO'S PATENTS USING PROPER CLAIM CONSTRUCTION METHODOLOGY

Sashco attempts to manufacture a legal issue of significance where there is none by accusing the district court of relying "first and foremost" on certain extrinsic evi-

dence—dictionary definitions—in construing the claims of Sashco's patents. Petition, p. 13. Sashco's argument (1) misrepresents the district court's claim construction methodology; (2) misstates the law regarding the use of dictionaries in claim construction; and (3) omits to inform this Court that, in its motion for partial summary judgment, Sashco itself urged the district court to begin its claim interpretation by resorting to a dictionary.

A. The District Court Correctly Found No Infringement of the '458 Patent

1. *DAP's cartridge product is not covered by the '458 Patent*

The district court correctly found, and the Federal Circuit agreed, that a functionality required by Claim 1 of the '458 Patent was missing from DAP's accused caulk cartridge. Claim 1 describes the patented device as a product consisting of a substantially transparent tubular housing containing a substantially transparent caulking compound, and further describes the required functionality, which is missing from DAP's accused product, as follows:

> "the combination of said housing and said caulking compound is substantially transparent in the transverse direction so as to allow a user to see completely through the surrounding sidewall and through the caulking compound from one side of the cartridge to the other whereby the substrate may be viewed through the combination of the housing and the caulking material placed therein so that the appe[a]rance of the substrate as affected by the caulking material may be seen prior to application of the caulking material . . . ."

D-6, col. 7, ln. 41—col. 8, ln. 5.

This required functionality is not found in DAP's cartridge because more than 50% of the exterior of its cartridge was covered with an opaque mask; accordingly, instead of being "substantially transparent", DAP's car-

tridge was *substantially non-transparent*. Thus, the question for the district court was whether the functionality set forth in Claim 1 covers devices that do not permit a view through the *center* of the cartridge, such as DAP's accused cartridge product. The primary language in the claim that needed construction was the requirement of transparency "in the *transverse direction* so as to allow a user to see . . . *from one side of the cartridge to the other*." D-6, col. 7, ln. 43-46. (Emphasis added).

Considering the plain language of the claim, the district court logically found that the requirement of seeing "from one side of the cartridge to the other" must mean that the user can see either (1) from a point on the cartridge to an *opposite* point or (2) from a point on the cartridge to *any* other point, even a point an infinitesimal distance away. App. A-27. The district court found (correctly, in the view of the Federal Circuit) that the former interpretation is proper because the phrase "in the transverse direction" suggests that the view must be to an opposite point. App. A-26–A-27.

The district court also noted that a contrary interpretation would result in the '458 Patent encompassing a substantially opaque cartridge with a viewing window just wide enough to allow the user to see from one point to any other. App. A-27. That construction, of course, is impossible in light of the '458 Patent's prosecution history. App. A-28–A-29. Since the mask on the DAP cartridge covers over 50% of the circumference, the user cannot see through the cartridge from any point on the cartridge to an opposite point, and there is no infringement of the '458 Patent.

2. *The district court did not err in consulting dictionaries during its claim construction*

Although Sashco now takes issue with the district court's use of dictionaries as an aid in claim construction, Sashco fails to mention that when it asked the

district court to adopt its erroneous construction of the '458 Patent, the first "evidence" Sashco presented was extrinsic evidence—a dictionary definition of the word "transverse". Respondent's Appendix at 13a-14a. Sashco then provided the district court with a brief excerpt from the prosecution history to support its construction based on that dictionary definition, followed immediately by another dictionary definition—the meaning of the word "across"—in order to explain the prosecution history. *Id.*

Moreover, the district court did not rely "first and solely" upon extrinsic evidence in construing the claims of Sashco patents (even though Sashco invited the district court to look "first" at dictionary definitions). What the district court did was to look at dictionary definitions of critical words used in the patent claims in the course of construing the patents. The district court did this only *after* it already had considered the language of the claims at issue, and had explained critical parts of the prosecution history of each patent, in the earlier sections of its opinion. App. A-14–A-19. Thus, the district court resorted to intrinsic evidence initially and, following the references to dictionary definitions, it again consulted intrinsic evidence in the specifications and prosecution history as aids in construction. App. A-26–A-30.

By employing dictionary definitions of such words as "transverse" and "across", as well as by consideration of such intrinsic evidence as the claims and the prosecution history, the district court properly construed the '458 Patent and correctly held that an off-center view—into the cartridge at one point on its surface and then out at *any* other point (*e.g.*, including those points just an infinitesimal distance away on the surface of the cartridge) —would be inconsistent both with the specification of a "transverse direction" of view in the patent claim, and with prosecution history limitations against the patentability of a mere viewing window (that allows a user to see into, but not through, the cartridge). App. A-27–A-28.

3. *Even if the district court looked first at dictionary definitions (which it did not), a dictionary may be consulted at any time during claim construction*

Neither *Markman v. Westview Instruments,* 52 F.3d 967 (Fed. Cir. 1995), *aff'd,* —— U.S. ——, 116 S. Ct. 1384 (1996), nor *Hoechst Celanese Corp. v. B P Chem.,* 78 F.3d 1575 (Fed. Cir.), *cert. denied,* —— U.S. ——, 117 S. Ct. 275 (1996), place any particular sequence upon the use of extrinsic evidence by the district court. The district court may not use extrinsic evidence to alter claim language, *Markman,* 52 F.3d at 981, but intrinsic evidence also may not be used for such purposes. *Id.* at 980. Beyond that, *Markman* and *Hoechst* place no limitation on the sequencing of evidence in the claims construction calculus.

In *Vitronics Corp. v. Conceptronic, Inc.,* 90 F.3d 1576, 1584-85 (Fed. Cir. 1996), the case primarily relied upon by Sashco, the Federal Circuit held that *certain kinds* of extrinsic evidence should not be considered in construing a claim unless that claim construction question cannot be resolved solely by reference to intrinsic evidence. However, the extrinsic evidence at issue in *Vitronics* was deposition testimony of an engaged expert. *Id.* at 1585. With respect to dictionary definitions, *Vitronics* held:

> "Although technical treatises and dictionaries fall within the category of extrinsic evidence, as they do not form a part of an integrated patent document, they are worthy of special note. *Judges are free to consult such resources at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms,* so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents."

Id. at 1584 n.6 (emphasis added).

Thus, although the district court looked to the dictionary only after first analyzing the language of the claims, it was free to resort to dictionary definitions at any time. Accordingly, the district court did not depart from *Markman* or *Hoechst*, and faithfully adhered to proper claim construction methodology (*i.e.*, reading dictionary definitions) originally proposed by Sashco and recently approved in *Vitronics*.

4. *The district court did not err in analyzing the '458 Patent as a tubular cartridge*

Sashco mistakenly asserts that the district court's analysis was flawed because it focused on a cylindrical cartridge even though the word "cyclindrical" is not found in Claim 1. Petition, p. 17. However, the word "tubular" as used in Claim 1 of the '458 Patent is synonymous with the word "cylindrical."[3] Sashco's apparent belief that all cylinders are "circular", is incorrect; any "cylinder", just like any "tube", may have a non-circular cross-section,[4] a fact of which the district court was aware and so indicated.[5]

When the district court analyzed Sashco's cartridge as a "circular cylinder," it expressly did so not as a limitation on the scope of the patent but because in this case "it is most helpful to think about [the patent's] de-

---

[3] Roget's International Thesaurus (4th ed. 1977) at Category 255.4 (p. 161) (classifying "tube" as an included synonym of "cylinder") ; Webster's New Collegiate Dictionary (1981 ed.) p. 1247 (defining "tube" as "a hollow elongated cylinder").

[4] A "cylinder" typically is defined as "the surface traced by a straight line moving parallel to a fixed straight line and intersecting a fixed curve." Webster's New Collegiate Dictionary, p. 281. The "fixed curve" intersected by a cylinder's surface, which defines the cylinder's cross-section, need not be circular.

[5] *See* App. A-24, where the district court distinguishes between a "cylindrical cartridge", generally, and a "circular cylinder", defining the latter as "a cylinder whose bases are circles".

scription in terms of circles." App. A-24. Indeed, in the '014 Patent, the same inventor and draftsman as were involved in the '458 Patent repeatedly used the terms "tubular" and "circular" interchangeably in describing the devices covered by the '014 Patent.[6] Thus, there was no error in the district court's claim construction.

B. The District Court Correctly Found No Infringement of the '014 Patent

With respect to the '014 Patent, no claim construction or interpretation is or was required. Claim 1 (the only independent claim) requires a specific structure that simply does not exist in DAP's accused squeeze tube. That specific structure is set forth in the claim language as follows:

> "said container having a region of reduced thickness in a direction transverse to the longitudinal axis longitudinally adjacent the upstream end of the container so that the caulking compound in the region of reduced thickness has a substantially uniform, flattened configuration . . . ."

E-8, col. 7, ln. 5-10.

Because DAP's squeeze tube gradually tapered from one end to the other, like a wedge or "toothpaste-type" squeeze tube, it had no identifiable "region of reduced thickness" that was "substantially uniform" and "flattened" at the sealed end of the tube (or anywhere on the tube). Although the district court consulted a dictionary and looked for related, explanatory language in the patent's specification, App. A-36–A-37, the district court ultimately reached the obvious conclusion that "flattened" means "flattened," *i.e.*, a region that has "less slope" than the rest of the tube. App. A-37. With that "interpretation" in hand, the district court then reached the further, equally obvious,

---

[6] E-6, col. 3, ln. 10-16; E-6, col. 4, ln. 49-53; E-8, col. 7, ln. 39-41.

non-infringement conclusion, stating that "upon even a cursory examination of [DAP's] squeeze tube, it becomes quite clear that there is no flattened region at the end of the tube." App. A-38.

Sashco's argument that the district court's construction reads Sashco's disclosed preferred embodiment out of the patent, Petition, p. 23, is meritless. The textual disclosure of the preferred embodiment in the specification of the '014 Patent requires the same "substantially uniform" and "flattened" region of reduced thickness adjacent to the upstream end of the patented device as is required by Claim 1. E-6, col. 4, ln. 68—col. 5, ln. 6. Figures 1, 2 and 3 of the '014 Patent, E-2, E-3 (renderings of the preferred embodiment), each illustrate by shading, striations or annotation (referred to as "region 34" with longitudinal dimension "d") a physically distinct, "flattened" region of reduced thickness—in the district court's words, an area with "less slope"—at the upstream end of the tube. It is this marked reduction in thickness or change in slope found in the disclosure of the preferred embodiment that is required by Claim 1 but which does not exist in DAP's accused device. Accordingly, the district court's construction of the '014 Patent, and the finding of non-infringement, does not read Sashco's preferred embodiment out of the patent.[7]

Finally, Sashco asserts that Claims 8 and 9 of the '014 Patent cover toothpaste-type tubes. Petition, p. 23. However, whatever devices are encompassed by Claims 8 and 9, those claims are dependent on Claim 1 and, accord-

---

[7] The patent examiner, in fact, expressly found that the '014 Patent does not extend to "toothpaste-type" squeeze tubes. The examiner on re-examination found that clear caulk in clear plastic squeeze tubes was "old and conventional." L43. According to the patent examiner, the feature of the '014 Patent that made it patentable over toothpaste-type squeeze tubes was the addition of this "substantially uniform" and "flattened" "region of reduced thickness". *Id.*

ingly, contain the limitations of Claim 1, including the "substantially uniform" and "flattened" "region of reduced thickness" recited in Claim 1, and not found in an ordinary toothpaste-type tube.[8]

II. SASHCO HAS RAISED NO SIGNIFICANT LEGAL ISSUE OF GENERAL APPLICATION BUT, RATHER, ASKS THE COURT TO CORRECT CLAIM CONSTRUCTION WITH WHICH IT DISAGREES

Even if the district court's claim construction was erroneous (which it was not), this Court does not sit to correct errors where the Court's decision will affect only the parties before it. Sashco has no legitimate argument with the district court's claim construction methodology, and its petition is a thinly-veiled attempt to gain another bite of the apple after its attempts to expand the scope of its patents were rejected by the district court and the Federal Circuit. Moreover, any error below can hardly impact "the law of claim construction to be applied in the future", Petition, p. 13, where the district court's opinion is unpublished and the Federal Circuit affirmed without opinion.

"The jurisdiction [of the Supreme Court to review cases by way of certiorari] was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing." *Magnum Import Co. v. Coty*, 262 U.S. 159, 163, 43 S. Ct. 531, 532 (1923). As Chief Justice Taft noted long ago,

---

[8] Sashco cannot expand an independent claim *beyond its explicit limitations* by pointing to dependent claims that are said to be of the same or a broader scope:

> "While it is true that dependent claims can aid in interpreting the scope of claims from which they depend, they are only an aid to interpretation and are not conclusive. *The dependent claim tail cannot wag the independent claim dog.*"

North Am. Vaccine v. American Cyanamid Co., 7 F.3d 1571, 1577 (Fed. Cir. 1993), *cert. denied*, 511 U.S. 1069, 114 S. Ct. 1645 (1994) (emphasis added).

> "No litigant is entitled to more than two chances, namely, to the original trial and to a review, and the intermediate courts of review are provided for that purpose. When a case goes beyond that, it is not primarily to preserve the rights of the litigants. The Supreme Court's function is for the purpose of expounding and stabilizing principles of law for the benefit of the people of the country, passing upon constitutional questions and other important questions of law for the public benefit. It is to preserve uniformity of decision among the intermediate courts of appeal."

Taft, C.J., in Hearings Before the House Committee on the Judiciary, 67th Cong., 2d Sess., ser. 33, at 2 (1922). *Accord*, *Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U.S. 387, 393, 43 S. Ct. 422, 423 (1923) ("[I]t is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal.")

This case presents no issues that affect any person other than the parties. It involves no constitutional issues or any split in authority among the circuits. Instead, Sashco alleges an error in patent claim construction concerning the specific patents owned by Sashco. Standing alone, these alleged errors do not warrant Supeme Court review. This Court "is not, and never has been, primarily concerned with the correction of errors in lower court decisions." Vinson, C.J., Address to the American Bar Ass'n (Sept. 7, 1949), 69 S. Ct. v, vi.[9] Accordingly, Sashco's petition should be denied.

---

[9] In 1995, Supreme Court Rule 10 was amended to state:

> "A petition for a writ of certiorari is rarely granted when the asserted error consists of . . . the misapplication of a properly stated rule of law."

Sup. Ct. R. 10.

III. SASHCO HAS NO "RIGHT" TO AN OPINION ON APPEAL, AND SASHCO CAN POINT TO NO EVIDENCE THAT THE FEDERAL CIRCUIT DID NOT REVIEW THE DISTRICT COURT'S DECISION *DE NOVO*

Sashco complains that the Federal Circuit did not issue a written opinion of its affirmance of the district court and, therefore, it cannot determine whether the district court's decision was reviewed *de novo*. Petition, pp. 8-13. "There is no requirement in law that a federal appellate court's decision be accompanied by a written opinion." *Furman v. United States*, 720 F.2d 263, 264 (2d Cir. 1983). The increasing caseload of the federal judiciary demands that courts issue summary dispositions in cases with no precedential value and where no dissenting views exist among the judges hearing the case. *United States v. Baynes*, 548 F.2d 481, 483-84 (3d Cir. 1977); *NLRB v. Amalgamated Clothing Workers of Am.*, 430 F.2d 966, 971-72 (5th Cir. 1970).[10]

Furthermore, Sashco cannot complain that it did not receive the proper standard of review. "Appeals whose judgments are entered under [Federal Circuit] Rule 36 receive the full consideration of the court, and are no less carefully decided than the cases in which we issue full opinions." *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1556 (Fed. Cir. 1997). Thus, Sashco's question as to whether it received a *de novo* review of the district court's decision already has been answered in the affirmative by the Federal Circuit.

---

[10] This Court has itself sanctioned this procedure:

> "We, of course, agree that the courts of appeals should have wide latitude in their decisions of whether or how to write opinions. That is especially true with respect to summary affirmances."

Taylor v. McKeithen, 407 U.S. 191, 194 n.4, 92 S. Ct. 1980, 1982 n.4 (1972).

CONCLUSION

For the foregoing reasons, the petition should be denied.

Respectfully submitted,

JEFFREY T. COX
Counsel of Record
PAUL G. HALLINAN
THOMAS R. KRAEMER
FARUKI GILLIAM & IRELAND
P.L.L.
600 Courthouse Plaza, S.W.
10 North Ludlow Street
Dayton, Ohio 45402
(937) 227-3704
Counsel for Respondent
DAP Products Inc.

APPENDIX

APPENDIX

IN THE UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION (DAYTON)

Case No.: C-3-92-407

Judge Rice

DAP PRODUCTS, INC.
855 North Third Street
Tipp City, Ohio 45471

Plaintiff,

v.

SASHCO, INC.
3900 East 68th Avenue
Commerce City, Colorado 80022

Defendant.

DEFENDANT SASHCO'S MOTION FOR PARTIAL SUMMARY JUDGMENT

Defendant, Sashco, Inc. ("Sashco") by and through its attorneys, hereby moves this Court, pursuant to Fed. R. Civ. P. 56, for partial summary judgment in its favor on the First and Second Counterclaims for Relief (and against DAP Products on its converse declaratory judgment claims) that the DAP Clear Cartridge Product infringes Sashco's U.S. Patent 4,776,458, (the "'458 Patent") that the DAP Clear Squeeze Tube Product infringes Sashco's U.S. Patent No. 4,863,014 (the "'014 Patent"). Sashco also requests summary judgment that DAP Products' claims against Sashco for alleged false advertising and unfair competition are limited in time to

acts after September 20, 1991. In support of its motion, Sashco states as follows:

1. Sashco is the owner of the '458 Patent, issued on October 11, 1988. A true and correct copy of the '458 Patent is attached to the Memorandum in Support of Sashco's Motion for Partial Summary Judgment as Exhibit A.

2. Sashco is the owner of the '014 Patent, issued on September 5, 1989. A true and correct copy of the '014 Patent is attached to the Memorandum in Support of Sashco's Motion for Partial Summary Judgment as Exhibit B.

3. On May 2, 1994, Sashco filed its Answer to DAP Products' Complaint, in which Sashco counterclaimed that DAP Products had infringed the '458 Patent through its manufacture and sale of the "DAP Clear Cartridge Product". Sashco also counterclaimed that DAP Products had infringed the '014 Patent through its mnaufacture and sale of the "DAP Clear Squeeze Tube Product".

4. In addition, Sashco raised the affirmative defense that damages for claims arising prior to September 20, 1991 are barred.

5. By this motion, Sashco seeks partial summary judgment in its favor and against DAP Products, asking the Court to rule that DAP Products, activities with respect to these two products infringe upon both the '458 Patent and the '014 Patent. Sashco also asks this Court to find that any claims alleged against Sashco by DAP Products in this action can only extend from September 20, 1991.

6. Plaintiff asserts that the undisputed facts herein justify the granting of Sashco's present motion.

7. Plaintiff's Memorandum in Support of Its Motion for Partial Summary Judgment is filed simultaneously herewith.

Dated this 30th day of November, 1995.

Respectfully submitted,

By: /s/ Timothy J. Martin
TIMOTHY J. MARTIN, ESQ.
TIMOTHY J. MARTIN, P.C.
9250 W. 5th Ave., Suite 200
Lakewood, Colorado 80226
(303) 232-3388

JEROME C. RANDOLPH
(0021808)
1800 Provident Tower
One East Fourth Street
P.O. Box 1800
Cincinnati, Ohio 45202
(513) 579-6431
Attorney for Defendant,
Sashco, Inc.

Of Counsel:

KEATING, MUETHING & KLEKAMP
1800 Provident Tower
One East Fourth Street
P.O. Box 1800
Cincinnati, Ohio 45202
(513) 579-6431

TIMOTHY J. MARTIN, ESQ.
TIMOTHY J. MARTIN, P.C.
9250 W. 5th Avenue, Suite 200
Lakewood, Colorado 80226
(303) 232-3388

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing DEFENDANT SASHCO'S MOTION FOR PARTIAL SUMMARY JUDGMENT was served upon J. Faruki and David A. Shough, Attorneys for Plaintiff, Faruki Gilliam & Ireland, 600 Courthouse Plaza, S.W., 10 North Ludlow Street, Dayton, Ohio 45402 by ordinary U.S. mail, this 30th day of November, 1995.

/s/ Cherise L. Knox

IN THE UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION (DAYTON)

Case No.: C-3-92-407

Judge Rice

DAP PRODUCTS, INC.
855 North Third Street
Tipp City, Ohio 45471

Plaintiff,

v.

SASHCO, INC.
3900 East 68th Avenue
Commerce City, Colorado 80022

Defendant.

DEFENDANT SASHCO'S MEMORANDUM IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT

Comes Now Sashco, Inc. ("Sashco") and submits the following as its memorandum in support of its Motion For Partial Summary Judgment filed concurrently herewith:

I. Background

Sashco is a manufacturer of building industry products, specifically caulks and sealants, which began as a family enterprise during the 1930's. In 1972, Lester Burch, the son of the company's founder, graduated from college with his degree in chemical engineering and became the chief executive of Sashco. In about 1976, he was joined by Wayne Summons who had graduated with Mr. Burch and who also holds a degree in chemical engineering.

Until the mid-1980's, Sashco primarily marketed its products on a regional basis, primarily in Colorado and the surrounding states. In the early 1980's, however, Burch and Summons conceived a product now known under the federally registered mark Lexel. The introduction and subsequent marketing of the Lexel product propelled Sashco into the national arena.

The sealant compound in the Lexel product is a block copolymer rubber (a sealant is a type of caulk). The primary version of the Lexel product is a transparent sealant that is marketed in a transparent container, namely a transparent cartridge and a transparent "toothpaste-type" squeeze tube.[1] These transparent products will hereinafter be referred jointly as the Clear Lexel Product and separately as the Clear Lexel Cartridge Product and the Clear Lexel Squeeze Tube Product.

The marketing appeal of the Clear Lexel product is its see-through presentation. That is, a customer can see completely through the combination of the container sidewall and the sealant from one side to the other in a direction that is transverse to the container's longitudinal axis. The Clear Lexel Products garnered six industry packaging awards in the late 1980's.

Sashco had the foresight to patent its innovative packaging combinations. In 1988, the United States Patent Office issued U.S. Patent No. 4,776,458 (the "'458 Patent") covering the Clear Lexel Cartridge Product, and in 1989, the Patent Office issued U.S. Patent No. 4,863,014 (the "'014 Patent") to Sashco for the Clear Lexel Squeeze Tube product. Copies of the '458 Patent and the '014 Patent are attached hereto as Exhibits A and B. The Clear Lexel Products are shown in Exhibit C.

Neither of Sashco's patent is directed to the chemical formulation of the sealant compound. Rather, each of

---

[1] Sashco also markets an opaque white version of the Lexel product.

these patents claims the combination of a clear caulking material as packaged in a see-through container. Sashco specifically pointed out to the Patent Examiner that it did not invent clear caulks or clear containers. (Exhibit A, col. 1, lines 32-58; Exhibit B, col. 1, lines 5-31)

Sashco was prudent in taking the effort to gain patent protection for its Clear Lexel Products. In the fall of 1988, one of the largest competitors in the industry, Red Devil, Inc., introduced a copycat cartridge product and later a copycat squeeze tube product. Sashco sued upon issuance of the '458 Patent.[2] Red Devil subsequently confessed its infringement of the '458 Patent and changed its packaging.[3]

The history of the present controversy dates to 1989/1990. At that time, the entity known as Dap, Inc. ("Old Dap") was a subsidiary of USG Corporation. Old Dap's product manager, David Groene, who was in charge of developing new products for the company had seen the success of the Lexel Clear Products and decided that Old Dap should capitalize on Sashco's invention, as well. Exhibit D. Thus, in 1990, Old Dap introduced the Dap Clear product, and Sashco again was forced to defend its patents in court (the "Old Dap Litigation").

In the Old Dap Litigation, Sashco sued for infringement of the '458 Patent and the '014 Patent for Old Dap's variations of its Clear products, including the ones that are the subject of this suit. These will be referred to jointly as the DAP Clear Products and separately as the

---

[2] *Sashco, Inc. v. Red Devil, Inc.*, Civ. Act. No. 88-C-1639 (Dist. Colo.)

[3] In 1993 Sashco filed a motion for contempt on a redesigned version of the Red Devil Cartridge product. Concurrently, Red Devil filed a declaratory judgment action in New Jersey seeking a declaration of non-infringement by the redesigned cartridge product and the Red Devil squeeze tube product. These matters were settled by the parties.

DAP Clear Cartridge Product and the DAP Clear Squeeze Tube Product. Old Dap counterclaimed for noninfringement and invalidity on the same grounds raised in this action. In discovery, Old Dap also raised as relevant to the suit the same alleged false advertising and unfair competition claims that are at issue in this action.

During the pendency of the Old Dap Litigation, specifically on September 20, 1991, the majority of the assets of Old Dap were sold to Wassall Acquisitions, Inc.. On that day, Wassall apparently changed its name to Dap Products, Inc. ("Dap Products"), Plaintiff in this action and Old Dap contemporaneously changed its name to La Mirada, Inc. Dap Products continued the business of Old Dap without interruption. This included the continued manufacture and sale of the infringing DAP Clear Products.

Old Dap (La Mirada) finally did confess its infringements of both of Sashco's patents about one year later, Exhibit E, and was enjoined from the manufacture of the infringing products. Old Dap also released Sashco from any claims it had related to the Old Dap Litigation. This release is shown in Exhibit F. During this time, though, Dap Products continued its manufacture and marketing of the infringing DAP Clear Products and instituted this action for declaratory judgment; DAP Products also attacked Sashco for alleged acts of unfair competition.

Sashco filed a motion for contempt against Dap Products in the Old Dap Litigation, arguing that Dap Products was merely a successor in interest who took the assets *pendente lite* and was therefore bound by the consent decree of Old Dap. Dap Products asserted that it was a completely new and legally unrelated entity. See, Exhibit G. The Colorado Court agreed with Dap Products and ruled that the injunction against Old Dap did not enjoin Dap Products.

Accordingly, Sashco has again been compelled in this Court to sue yet again for infringement by the same DAP Clear Products found to be infringing in the Old Dap Litigation. Sashco seeks summary judgment on these infringement claims as well as a ruling that any damages for claims alleged against Sashco in this action by Dap Products can only extend from September 20, 1991, and not before. Sashco does not in this motion and memorandum address the lack of basis for DAP Products' claims.

II. Issues

1. Does the Dap Clear Cartridge Product Infringe Sashco's '458 Patent?
2. Does the Dap Clear Squeeze Tube Product infringe Sashco's '014 Patent?
3. Are Dap Products claims against Sashco for alleged false advertising and unfair competition limited in time to acts after September 20, 1991?

II. Legal Argument

A. *General Guidelines Governing Motions for Summary Judgment*

The primary principles governing motions for Summary Judgment are well established. Pursuant to Rule 56, Fed. R.Civ.P., Summary Judgment is appropriate in cases where no genuine issue of material fact exists, and the moving party shows that it is entitled to judgment as a matter of law. It is the moving party's burden to establish the absence of a genuine issue of material fact by showing that there is an absence of evidence to support the non-moving party's case, *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548, 2554, 91 L.Ed.2d 265 (1986). Any doubt is to be resolved against the moving party. *Petersen Manufacturing Co. v. Central Purchasing, Inc.*, 740 F.2d 1541, 1546, 222 U.S.P.Q. 562, 565-66 (Fed. Cir. 1984).

While the Federal Circuit has cautioned that a Motion for Summary Judgment on the issue of infringement must be approached carefully by the District Court, *See generally, Palumbo v. Don-Joy Co.*, 762 F.2d 969, 226 U.S.P.Q. 5 (Fed. Cir. 1985), the Court has also recognized that a comparison of a properly interpreted claim with a stipulated or uncontested description of an accused device would reflect such an absence of material fact issues as to warrant Summary Judgment on the matter of infringement. *Chemical Engineering Corp. v. Essef Industries, Inc.*, 795 F.2d 1565, 230 U.S.P.Q. 385 (Fed. Cir. 1986). Moreover, a dispute as to the legal issue of claim interpretation does not preclude Summary Judgment because the function of applying claims to the accused device is within the province of the District Court. *Molinaro v. Fannon/Courier Corp.*, 745 F.2d 651, 654, 223 U.S.P.Q. 706, 708 (Fed. Cir. 1984). Moreover, Summary Judgment is quite appropriate where it is clear what the truth is. *Sartor v. Arkansas Natural Gas Corp.*, 321 U.S. 620, 627, 64 S.Ct. 724, 728-29, 88 L.Ed. 967 (1944).

B. *Framework for Patent Infringement Analysis*

A proper resolution of the patent infringement issue involves a two-step analysis. First and foremost, the patented invention, as it is defined by the language of the patent's claims, must be defined. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 U.S.P.Q. 2d 1593 (Fed. Cir. 1987). Improper claim construction can distort the entire infringement analysis. *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 656 (Fed. Cir. 1986). Once the claims have been properly construed, then the next step is to determine whether the accused product(s) falls within those claims. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1269-70, 229 U.S.P.Q. 805 (Fed. Cir. 1986). This second analytical step is a question of fact. *Id.* at 1270.

With respect to the first analytical step, patent claims need be clear enough to provide reasonable guidance to

those whom the patent affects, but the patent system cannot fairly achieve this purpose if there is an unreasonably high standard of particularly in claim draftsmanship. If the language of a claim is undisputed, then its scope is construed as a matter of law. *E.g., Windsurfing International, Inc. v. AMF, Inc.*, 782 F.2d 994, 228 U.S.P.Q. 562 (Fed. Cir. 1986). Words are to be given their ordinary and accustomed meaning unless it appears that the inventor intended otherwise. *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 137 F.2d 3, 6, 54 U.S.P.Q. 504 (7th Cir. 1943), *aff'd*, 322 U.S. 471, 64 S.Ct. 1110, 88 L.Ed. 1399 (1944); *E.g., Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc.*, 887 F.2d 1070, 1073-74, 12 U.S.P.Q. 2d 1539 (Fed. Cir. 1989) (dictionary definitions are relevant but not conclusive). However, consistency in claim interpretation is important, and words defined in a specification must be given the same meaning when used in a claim. *General Electric Co. v. United States*, 572 F.2d 745, 753, 198 U.S.P.Q. 65, 71 (Ct.Cl. 1978); *Howes v. Medical Components, Inc.*, 814 F.2d 638, 644 and 647, 2 U.S.P.Q. 2d 1271 (Fed. Cir. 1987) (it is error to construe a claim in a manner inconsistent with the specification).

With respect to the second analytical step, it is axiomatic that because each element of a claim is material and essential, the patentee must show the presence of every element of the claim, or its substantial equivalent, in the accused device. *See, Panduit Corp. v. Dennison Manufacturing Co.*, 774 F.2d 1082, 227 U.S.P.Q. 337 (Fed. Cir. 1985). Thus, a claim reads on a product or process if that product or proces has every element or limitation of the claim. *Builders Concrete, Inc. v. Bremerton Concrete Products Co.*, 757 F.2d 255, 257, 225 U.S.P.Q. 240, 241 (Fed. Cir. 1985).

C. *The Claims of the Patents at Issue Are Easily Construed.*

1. *The '458 Patent.*

Sashco's '458 Patent relates to a product for use in the building industry. Claim 1 appears at columns 7 and 8 of the '458 Patent, as follows:

Column 7

> 1. A product for use in the building industry, comprising a cartridge formed as an elongated tubular housing having a longitundinal axis and surrounding sidewall fabricated of a transparent material, said housing having a hollow interior, a nozzle member enclosing a downstream end of said cartridge, a substantially transparent cauking compound contained in said cartridge, said caulking compound adapted to be placed on a substrate, and a piston member slideably received in the interior of said cartridge and enclosing an upstream end thereof so that the piston member may be pressed against the caulking compound to force the caulking compound out of said nozzle member as said piston member is moved downstream through said housing to dispense said caulking material onto said substrate whereby the combination of said housing and said caulking compound is substantially transparent in the transverse direction so as to allow a user to see completely through the surrounding sidewall and through the cauking compound from one side of the cartridge to the other

Column 8

> whereby the substrate may be viewed through a combination of the housing and the caulking material placed therein so that the appearance of the substrate as affected by the caulking material may be seen prior to application of the caulking material

and whereby the position of the piston member may be viewed as the caulking material is dispensed from the housing.

Claim 1 of this patent includes four main structural components: (1) a cartridge formed as an elongated tubular housing having a longitudinal axis and a surrounding sidewall fabricated from a transparent material; (2) a nozzle member which encloses a downstream end of the cartridge; (3) a substantially transparent caulking compound contained in the cartridge; and (4) a piston member which is slideably received in the interior of the cartridge to dispense the caulking compound out of the nozzle member.

Claim 1 further recites that the combination of the housing and the caulking compound is substantially transparent in the transverse direction with the claimed advantage of this feature being that it permits a user to see completely through the surrounding sidewall and the caulking compound from one side of the cartridge to the other, thereby allowing a user to both see the substrate's appearance before application of the caulking compound and to view the position of the piston member during application.

The longitudinal direction of the cartridge product claimed in the '458 Patent is not disputed—it is the direction of the length of the cartridge in the elongated dimension. That is, from the piston end to the nozzle end. The transverse direction, then, is simply a direction that is cross-wise to a longitudinal axis since "transverse" means: "1. Lying situated, placed, etc. across; crossing from side to side; crosswise." *Webster's New Universal Unabridged Dictionary*, 2d Ed. (1983).

Claim 1 does not require that the transparency be absolute since absolute transparency is only obtained in a vacuum; rather, the combination must be substantially transparent. Thus, proper claim construction requires that the viewer be able to see crosswise through the substantially transparent combination of the sidewall and the com-

pound from one side to the other. That is, in through one sidewall portion of the housing, through the compound and out through another sidewall portion of the housing. This view must allow the viewer to see a substrate prior to application and permit viewing of the piston member during dispensing of the caulking compound from the housing.

The claim requires nothing more. It does not require that the view line be diametric, that it be perpendicular to the sidewall or that it intersect any particular longitudinal axis. This is supported by the test of the '458 Patent as well as the prosecution history. In the file wrapper, the relevant portion of which is attached hereto as Exhibit H, this claim 1 (then listed as claim 22) was amended to reflect:

> That the product is substantially transparent in the transverse direction *across* its longitudinal axis so as to allow a user to completely see through the surrounding sidewall and through the cauking compound from one side of the cartridge to the other. Exhibit H.

"Across", of course, means: "1. from one side to the other side of; athwart; as, a bridge is laid *across* a river." *Webster's New Universal Unabridged Dictionary*, 2d Ed. (1983).

2. *The '014 Patent.*

Sashco's '014 Patent also relates to a product for the building industry utilizing a collapsible tube as the housing. Claim 1 of this patent is found at Columns 6 and 7 and recites:

Column 6

> 1. A product for the building industry, comprising an elongated container having a longitudinal axis and an interior, said container including a surrounding sidewall, a first closure forming a down-

stream end of container and a second closure forming an upstream end of the container, a dispensing nozzle extending outwardly from said container at the downstream end thereof and having a flow passageway in fluid communication with the interior, and a substantially transparent caulking compound contained in the interior of the container,

Column 7

said sidewall being fabricated out of a flexible material whereby the container may be manually squeezed to dispense the caulking compound as an applied bead out of the dispening nozzle and onto a selected substrate surface, said container having a region of reduced thickness in a direction transverse to the longitudinal axis longitudinally adjacent the upstream end of the container so that the cauking compound in the region of reduced thickness has a substantially uniform, flattened configuration and wherein said sidewall has facing sidewall portions on opposite sides of said region of reduced thickness that are fabricated of substantially transparent material whereby the substrate surface may be viewed through the combination of the facing sidewall portions and the caulking material therebetween so that the appearance of the substrate surface as affected by the caulking material may be seen prior to the application of the caulking material.

This claim, therefore, again relates to a product which comprises a substantially transparent caulking compound packaged in a substantially transparent elongated container, but this container has a nozzle and a surrounding sidewall formed out of a flexible material that may be manually squeezed to dispense the compound onto a substrate.

A limitation in claim 1 is that the container has a region of reduced thickness in a direction transverse to

the longitudinal axis longitudinally adjacent the upstream end of the container so that the caulking compound in this region of reduced thickness has a substantially, uniform flattened configuration. The specification and figures of the drawings provide a single disclosed embodiment of this container in the form of a toothpaste-type squeeze tube, as conceded by Dap Products' patent expert, Mr. Killworth. Relevant portions of this deposition are attached as Exhibit I, and Mr. Killworth reluctantly acknowledges that the '014 Patent was granted based on figures which showed a toothpaste-type tube. Exhibit I, page 139, lines 10-24.

The text of '014 Patent makes it abundantly clear that the product is preferred to be in the form of a toothpaste-type squeeze tube. At column 4, lines 49-65 of the '014 Patent, Exhibit B, the construction of the toothpaste tube is described. The preferred container is made by taking a circular tubular member and collapsing one end into a flat linear margin. As further explained, this formation of the linear margin alone creates the claimed region of reduced thickness such that the caulking compound in that region, adjacent the upstream end, has a substantially uniform, flattened configuration. Column 5, lines 1-6 of the '014 Patent. (Exhibit B).

That claim 1 of the '014 Patent covers not only toothpaste-type squeeze tubes but also other constructions are borne out of the legal doctrine of claim differentiation. Claim differentiation is a claim construction rule that requires a broader interpretation of a parent claim where a dependent claim introduces narrower limitations. *See, Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q. 2d 1434 (Fed. Cir. 1988).

Claims 8 and 9 of the '014 Patent (Exhibit B) recite the language that requires the container to be a standard toothpaste-type squeeze tube. These claims state that the second closure is formed by collapsing a second end portion of said sidewall against itself along a linear region

transverse to said longitudinal axis and sealing said sidewall second end portion together to form a sealed margin at the upstream end of the container and that the tubular member is circular in cross-section. The doctrine of claim differentiation requires that each claim defines a separate invention. *Jones v. Hardy*, 727 F.2d 1524, 220 U.S.P.Q. 1021 (Fed. Cir. 1984). Therefore, claim 1 includes not only toothpaste-type collapsible containers but other collapsible container configurations so long as there is a region of reduced thickness longitudinally adjacent the upstream end so that the substrate surface may be viewed through the combination of the facing sidewall portions and the caulking compound in this region to allow the appearance of the substrate surface, as affected by the caulking material, to be seen prior to application of the caulking material.

D. *The DAP Clear Cartridge Product Literally Infringes the '458 Patent.*

There is no genuine issue of fact that the Dap Clear Cartridge Product infringes claims 1 and 2 of the '458 Patent. For infringement to be found, of course, it is only necessary that a single claim of the '458 Patent be infringed. *General Foods Corp. v. Studiegesellshaft Kohl MbH*, 972 F.2d 1272, 1282 (Fed. Cir. 1992)

DAP Products' own patent expert admits the DAP Clear Cartridge Product reads on every limitation in claim 1, excepting that the combination of the housing in the compound and its product is substantially transparent in the transverse direction. Killworth Deposition, Exhibit 1, page 76, lines 7-11. To avoid infringement, Dap Products urges this Court to accept that the word "transverse" means that the line of sight must be perpendicular to the sidewall and, thus, a user must be able to see through the product along a line that passes through (i.e., intersects) the central longitudinal axis of the cartridge. Such an improper claim construction essentially invites the Court to distort the infringement anaysis by reading a limitation

into claim 1 which is simply not present as it appears in the patent. Nor does the prosecution history of the '458 Patent support such a narrow intepretation. Improper claim construction distorts Mr. Kilworth's infringement analysis. *Moeller, supra.*

The proper construction of claim 1 appears above. Claim 2 adds to claim 1 that the caulking compound is a block copolymer rubber. If these claims read on the Dap Clear Cartridge product, then there is no genuine question of infringement. Photographs of this product appears as Exhibit J, and this product was identified as Exhibit DDX-4D in the discovery depositions taken in this case. Relevant pages of the deposition of Mr. Brian Mitchell, the head of Dap Products research and development section, are attached hereto as Exhibit K. He unequivocally testified that the Dap Clear Cartridge product was a clear sealant packaged in a clear Barex cartridge. (Exhibit K, page 25, lines 8-14; page 28, lines 20-22); page 29-30).

Dap Products' own patent expert, Mr. Killworth, testified during his deposition that lines 27-41 of claim 1 of the '458 Patent, read on the Dap Clear Cartridge Product. Exhibit I, page 76, lines 7-11. Upon later questioning, Mr. Killworth further agreed that the Claim 1 language limitations found at column 8 lines 1-8 of the '459 Patent read on the Dap Clear Cartridge Product. Quoting from the deposition:

> Q Let me direct your attention to the Column 8, Lines 1 through 5 which reads, "whereby the substrate may be viewed through the combination of the housing and caulking material placed therein so that the appearance of the substrate as affected by the caulking material may be seen prior to application of the caulking material." And I'll ask you, with regard to that specific language, whether that covers the old DAP cartridge, DDX-4D.

A You mean without the language which precedes it?

Q Yes.

A Just, can I view the substrate through that? Maybe if I stand on my head, yeah.

Q Well, short of standing on your head, are you able to view the combination of the housing and caulking material so that the appearance of the substrate may be seen prior to application if you maneuver—or manipulate the cartridge in a certain way?

A Yeah, you might be able to—if that's all there is to the question, yes, you might be able to see it through there.

Q Have you ever attempted to do that?

A Yes.

Q And you were able to do that, weren't you?

A Not easily, but yes.

Q Okay. And similarly, with regard to the language at Lines 5 through 7 of Column 8 which reads, "whereby the position of the piston member may be viewed as the caulking material is dispensed from the housing," putting aside the earlier language of the claim, you would be able to have that view on DDx-4D as well, wouldn't you.

A Yes.

Dap's patent lawyer expert, Mr. Killworth, only contends that there is no infringement of claim 1 based upon his improper claim interpretation that claim 1 requires that the line of view through the cartridge and the transparent compound be diametric through the central longitudinal axis of the cartridge. To reach this conclusion, however, Mr. Killworth relies on his own definitions of

"transparent", "transverse" and "across" which he did not bother to even look up in a dictionary. Exhibit I, page 89, lines 15-17. Moreover, he ignores the term "substantially transparent" in claim 1. He states, "Yes, I have ignored the term substantially in the claim." Exhibit I, page 98, lines 10-11. Yet he has previously used this term in patent prosecution to mean "mostly". Exhibit I, page 80, lines 22 through page 81, line 2.

Mr. Killworth has improperly defined "transverse" to mean "perpendicular". Exhibit I, page 83, lines 17-21. However, as stated above this term actually means "lying, situated, placed, etc., across; crossing from side-to-side; crosswise." Likewise, the primary definition of "across" does not limit the term to require intersection, as Mr. Killworth defines it. Exhibit I, page 100, lines 1-3. As noted above, "across" simply means "from one side to the other side of; athwart; as, a bridge is laid *across* a river." (In certain instances, of course, "across" includes "intersecting").

In their respective depositions, appended hereto, Messrs. Burch and Dr. Hauser had no difficulty in reading printed text through the Dap Clear Cartridge product in the transverse direction in the window area of the product. Exhibits M and O. Mr. Summons in his Expert Report likewise had no difficulty. Exhibit N. As noted above, Dap's own expert, Mr. Killworth, was able to undertake such viewing himself.

In the photographic Exhibit J, the Court may likewise observe that one can easily see transversely through the Dap Clear Cartridge product in the manner called for by Claim 1 of the '458 Patent.

Dap concedes that its sealant compound is a block copolymer rubber. Therefore, claim 2 is infringed. Exhibit K, page 26.

Thus, there is no real, genuine issue of disputed fact on which Dap may rely in arguing non-infringement of the

'458 Patent, and Sashco is entitled to summary judgment on this issue as a matter of law as to claims 1 and 2 of the '458 Patent.

E. *DAP's Clear Squeeze Tube Product Literally Infringes the '014 Patent.*

Here, again, Dap Products argues that it does not infringe based solely on a misconstruction of the claims of the '014 Patent. In his deposition, Dap Products' patent expert, Mr. Killworth, concedes that all of the limitations of claim 1 of the '014 Patent are present in the Dap Clear Squeeze Tube product, Exhibit I, page 135, lines 9 through page 136, line 4, except that Mr. Killworth believes that Claim 1 requires there to be a specially (that is, not merely formed by collapsing a tubular squeeze tube) formed or molded region of reduced thickness in claim 1. This, of course, improperly construes claim 1 of the '014 Patent and therefore distorts his infringement analysis. DAP Products' endeavor to read limitations into claim 1 which are not conveyed in its plain meaning should fail because a patent's claims are not limited to specific embodiments in the specification or illustrative examples. *E.g., Laitram Corp. v. Cambridge Wire Cloth Co..*, 863 F.2d 555, 9 U.S.P.Q. 2d 1289, 1299 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1068 (1989). As properly construed, the old '014 Patent undeniably covers toothpaste-type flexible housings. Section II.C.2. *supra.*

Attached hereto as Exhibit P are photographs of the Dap Clear Squeeze Tube product in the configurations of figures 1,2,3 and 5 of the '014 Patent. There can be no genuine question that this product is exactly what is talked about in the patent. Mr. Bross, an expert patent draftsman having drawn over 2500 sheets of patent drawings (including the formal drawings for the '014 Patent) testified without qualification that these figures represent a toothpaste-type squeeze tube and that he would depict the Dap

Clear Squeeze Tube product with drawings the same as those in the '014 Patent. Exhibit L, page 63-65.

Therefore, the Court may readily appreciate from a proper reading of the language of the claims of the '014 Patent that there is no genuine, real issue of material fact that the Dap Clear Squeeze Tube product infringes at least claims 1, and 8-15 of the '014 Patent.[4] Accordingly, Sashco is entitled to judgment as a matter of law on infringement of its '014 Patent.

F. *DAP Products Cannot Claim for Damages Before September 29, 1991.*

DAP Products acquired the general assets of Old DAP on September 20, 1991. Prior to that time, DAP Products was not in the business of selling caulk and sealant products and therefore could not have been damaged by lost sales of silicone products assuming *arguendo* that Sascho has unfairly competed with DAP Products, a claim which Sascho vigorously denies. DAP Products has vigorously and successfully contested that it is an entirely different entity that Old DAP. Exhibit G. Consistent with DAP Products position taken in 1993, Old DAP in 1992 clearly believed that it retained, after September 20, 1991, its claims against Sashco. Exhibit F.

In Exhibit F, Old DAP (La Mirada) unequivocally released Sashco from any liability that occurred prior to September 20, 1991. Exhibit F at para. 6.01. That claims of unfair competition could have been brought in the Old DAP Litigation is borne out by the very fact that DAP Products has raised this in this, a substantially similar action. Therefore, Old DAP's release bars any claim for damages prior to September, 1991.

Sashco is entitled to summary judgment in its favor against any claim for damages by DAP Products prior to September 20, 1991.

---

[4] Sashco also believes that the evidence would show infringement of claims 2-4 and 6 of the '014 Patent.

IV. Conclusion

Based on the foregoing arguments, and in light of the exhibits submitted herewith, it is unquestionable that DAP Products has directly infringed the '458 and '014 patents by its manufacture and sale of the DAP Clear Cartridge Product and the DAP Clear Squeeze Tube Product.

The Court should not be misled by DAP's misconstruction of the '458 Patent's claim language to require that a user must view exactly through the middle of the cartridge in order to infringe. Nor should the Court be misguided by DAP's endeavor to read into claim 1 of the '014 Patent unnecessary limitations which are not conveyed by its plain meaning. Such interpretations by DAP with respect to these two patents are not supported in the record before the Court.

Accordingly, granting of Sashco's Motion for Partial Summary Judgment is entirely appropriate.

Dated this 30th day of November, 1995.

Respectfully submitted,

By: Timothy J. Martin
TIMOTHY J. MARTIN, ESQ.
TIMOTHY J. MARTIN, P.C.
9250 W. 5th Ave., Suite 200
Lakewood, Colorado 80226
(303) 232-3388

Jerome C. Randolph
(0021808)
1800 Provident Tower
One East Fourth Street
P.O. Box 1800
Cincinnati, Ohio, 45202
(513) 579-6431
Attorney for Defendant,
Sashco, Inc.

Of Counsel:
KEATING, MUETHING
& KLEKAMP
1800 Provident Tower
One East Fourth Street
P.O. Box 1800
Cincinnati, Ohio 45202
(513) 579-6431

TIMOTHY J. MARTIN, ESQ.
TIMOTHY J. MARTIN, P.C.
9250 W. 5th Avenue,
Suite 200
Lakewood, Colorado 80226
(303) 232-3388

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing DEFENDANT SASHCO'S MEMORANDUM IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT was served upon J. Faruki and David A. Shough, Attorneys for Plaintiff, Faruki Gilliam & Ireland, 600 Courthouse Plaza, S.W., 10 North Ludlow Street, Dayton, Ohio 45402 by ordinary U.S. mail, this 30 day of November, 1995.

/s/ Cherise L. Knox